

The Office Action took the position that the features recited by the claims are required to be, i.e., must be, described in the detailed description portion of the application. The Office Action cites 37 C.F.R. 1.71, 1.73, and 1.75(d)(1) for support of the stated position.

Applicants respectfully, but forcefully, disagreed with the position taken by the Office Action for the following reasons.

Initially, Applicants respectfully pointed out that 37 C.F.R. 1.71(a) states “[t]he specification must include a **written description** of the invention . . . (emphasis added)” Furthermore, Applicants respectfully noted that 37 C.F.R. 1.75(d)(1) states “[t]he claims or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the **description** so that the meaning of the terms in the claims may be ascertainable by reference to the description. (emphasis added)”

Applicants noted that the “remainder of the specification” refers to the portion of the originally filed application that is not the claims, i.e., Background of the Invention, Summary of the Invention, Detailed Description of the Invention, and any drawings of the invention that were filed with the application.

Applicants respectfully acknowledge that for presentation purposes, 37 C.F.R. §1.73 states the Summary of the Invention portion of the Specification, i.e., written description, is to precede or come before the Detailed Description portion of the Specification, i.e., written description.

However, Applicants also note that 37 C.F.R. §1.75(d)(1) does not state “detailed description” in identifying a particular portion of the Specification, i.e., written

description, that is to provide antecedent basis for the claimed subject matter. Rather, 37 C.F.R. §1.75(d)(1) clearly uses the term “description” alone in identifying “where” antecedent basis is to be provided for the claimed subject matter.

Moreover, Applicants, upon further review of the relevant rules, note that nowhere do the rules state the terms “description” and “specification” are treated synonymously.

However, Applicants respectfully submit that the term “written description” includes the Specification and any drawings.

Additionally, Applicants respectfully submit that the term “description” alone in 37 C.F.R. §1.75(d)(1) has led to apparent confusion as to whether antecedent basis for claimed subject matter should be present in the “written description” as contended by the Applicants, or the “detailed description” as argued in the Office Action. In this regard, Applicants, upon review of the Federal Register and the M.P.E.P., respectfully submit that the term “description” in 37 C.F.R. §1.75(d)(1) is understood by the Patent Office as the “written description.”

For example, the Federal Register notes that for procedures used for determining whether the written description (emphasis added) adequately describes corresponding structure, material, or acts necessary to support claim limitations which invoke 35 U.S.C. §112, paragraph 6, 37 C.F.R. §1.75(d)(1) provides, in part, that:

[T]erms and phrases used in claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. In the situation in which the written description only implicitly or inherently sets forth the structure . . . corresponding to a mean- . . . plus-function, and the examiner concludes that one skilled in the art would recognize what structure . . . perform the function recited, . . . the examiner should either : (1) Have the applicant clarify the record by amending the written description such that

[the written description] expressly recites what structure . . . perform the function recited in claim element. See Federal Register: July 30, 1999 (Volume 64, Number 146, page 41393); Federal Register: June 21, 2000 (Volume 65, Number 120, page 38513); and M.P.E.P. §2181, the paragraph bridging pages 2100-213 and 2100-214 (August 2001 Edition).

Put simply, Applicants respectfully submit that as is clear from the citations of the Federal Register and the M.P.E.P., the term “description” in 37 C.F.R. §1.75(d)(1) is understood as the “written description” and not the “detailed description,” as argued by the Office Action.

Furthermore, Applicants further note that recent case law states that claims must find clear support or antecedent basis in the Specification, which is also defined as the written description of the invention. See MPEP § 608.01(o); 37 CFR § 1.71. See also, Laser Tech., Inc. v. Nikon, Inc., 215 F. Supp. 2d 1135 (D. Colo. 2002).

More importantly, clear support or antecedent basis is not limited to just the “detailed description” portion of the Specification. The Federal Circuit and numerous district courts have consistently held that the “written description” may include the Abstract, Summary of the Invention, Drawings, and Background of the Invention portions of the Specification. See, e.g., Storz Instrument Co. v. Alcon Lab., 1998 U.S. App. LEXIS 1082, (Fed Cir. 1998) (unpublished) (acknowledging that the written description consists of the background and summary of the invention); PMG, Inc. v. Stinger Spike Sys., 2002 U.S. Dist. LEXIS 17162, CA No. 5:98CV69, (N.D. W. Va 2002) (stating that the written description of the patent includes the specification and the drawings); Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313 (Fed. Cir. 2003); Honeywell Inc. v. Victor Co. of Japan, LTD., 298 F.3d 1317 (Fed. Cir. 2002); Benetton Sportssystem United States v. First Team Sports, 38 Fed. Appx. 599 (Fed. Cir. 2002)

(acknowledging that the drawings are a part of the written description); Cooper Cameron Corp. v. Kvaerner Oilfield Prods., 291 F.3d 1317 (Fed. Cir. 2002) (acknowledging that the drawings are a part of the written description); Maltezos v. AT&T Corp., 6 Fed. Appx. 850 (Fed. Cir. 2001) (acknowledging that the detailed description and the background section are parts of the written description of the patent); In re Baker Hughes Inc., 215 F.3d 1297 (Fed. Cir. 2000) (acknowledging that the detailed description and the background section are parts of the written description of the patent); General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272 (Fed. Cir. 2002) (stating that the drawings are part of the written description); Timken Co. v. SKF U.S.A., Inc., 193 F. Supp. 2d 813 (E.D. Pa. 2002) (stating that the written description is comprised of the summary and background of the invention); Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 2000 U.S. Dist. LEXIS 17352, CA No. 96-1718-C H/G, (S.D. Ind. 2000) (acknowledging that the abstract of the invention is one part of the written description of a patent); Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc., 141 F.3d 1084 (Fed. Cir. 1998) (stating that the background, summary and description of the preferred embodiment are components of the written description).

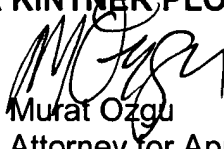
Given that the "written description" includes, at least, the Background of the Invention and Detailed Description portions of the Specification; that 37 C.F.R. §1.75(d)(1) fails to state "detailed" description in identifying "where" clear support or antecedent basis is to be provided in the description; that nowhere does 37 C.F.R. §1.71, §1.73, or §1.75 require that support or antecedent basis for claimed subject matter be provided in a particular portion, i.e., detailed description, of the originally filed application; and that according to the Federal Register and the M.P.E.P., the term

"description" in 37 C.F.R. §1.75(d)(1) is understood as the "written description" and not the "detailed description," as argued by the Office Action, Applicants respectfully submit that support or antecedent basis for the claimed subject matter may be provided anywhere within written description of an originally filed application wherein the written description includes the entire Specification and any drawings filed therewith.

Accordingly, unless relevant case law, comments during the federal rule making period, superceding statements within the Federal Register, or a superceding edition of the M.P.E.P. can be identified substantiating the position taken by the Office Action, Applicants respectfully submit the Office Action is attempting to impose a standard regarding clear support or antecedent basis and the "detailed description" that is not required by any relevant patent rule or law and is contrary to well established principles and guidelines of the U.S. Patent System.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 100725-00040.**

Respectfully submitted,
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